



PATENT
(116142-00080)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Pilon et al.
Serial No. : 09/835,784
Filed : April 13, 2001
For : ***METHODS AND COMPOSITIONS FOR THE TREATMENT OF
FIBROTIC CONDITIONS & IMPAIRED LUNG FUNCTION & TO
ENHANCE LYMPHOCYTE PRODUCTION***
Examiner : Romeo, David S.
Group Art Unit : 1647

919 Third Avenue
New York, NY 10022

I hereby certify that this correspondence
is being deposited with the United States
Postal Service as first class mail in an
envelope addressed to:

Commissioner for Patents,
P.O. Box 1450
Alexandria, VA 22313-1450, on November 3, 2003

Henry J. Cittone
Name of Applicant, Assignee or Registered
Representative

H. J. Cittone
Signature

November 3, 2003
Date of Signature

RESPONSE TO SEPTEMBER 15, 2003 RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Response is submitted in response to the Restriction Requirement issued on October
2, 2003 in connection with the above-identified application. The deadline for response to the

October 2, 2003 Restriction requirement is November 3, 2003, November 2, 2003 being a Sunday. Accordingly, this Response is being timely submitted.

In response to the Official Action mailed October 2, 2003, Applicants hereby elect, with traverse, for further prosecution in this application that invention identified in the Official Action as Group II, Claims 6-7, 13-14, 23-24, 31-32, 42-43, 51-52, 60-61, 69-70, 78-79, 89-90, 98-99, 107-108, 116-117, 123-124, 126-127, 129-130, 132-133, 135-136, and 138-139. This restriction requirement is respectfully traversed.

In the October 2, 2003 Restriction Requirement, the Examiner stated that restriction to one of the following inventions is required under 35 U.S.C. § 121:

- | | |
|-----------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Group I | Claims 1-5, drawn to a method of inhibiting an LPS-dependent inflammatory process, classified in class 424, subclass 9.1. |
| Group II | Claims 6-7, 13-14, 23-24, 31-32, 42-43, 51-52, 60-61, 69-70, 78-79, 89-90, 98-99, 107-108, 116-117, 123-124, 126-127, 129-130, 132-133, 135-136, and 138-139, drawn to a composition comprising recombinant human uteroglobin, classified in class 530, subclass 380. |
| Group III | Claims 8-12, drawn to a method of decreasing TNS-alpha concentrations in vivo, classified in class 424, subclass 9.1. |
| Group IV | Claim 15-22, drawn to a method regulating the nitric oxide pathway for relaxing smooth muscle cells, classified in class 424, subclass 9.1. |
| Group V | Claims 25-30, drawn to a method of regulating vascular permeability in a patient, classified in class 424, subclass 9.1. |
| Group VI | Claims 33-41, 44-50, 53-59, 62-69, and 71-77, drawn to a method of suppressing proliferation and activation of CD71-positive cells, classified in class 424, subclass 9.1. |
| Group VII | Claims 80-88, 91-97, 100-106, and 109-115 drawn to a method of enhancing proliferation and activation of CD11b-positive cells, classified in class 424, subclass 9.1. |

- Group VIII Claims 118-122, 125, 128, 131, 134, and 137, drawn to a method of inhibiting migration of vascular endothelial cells and angiogenesis, classified in class 424, subclass 9.1.
- Group IX Claims 140-154 and 161-169, drawn to a method of regulating signal transduction in uteroglobin-responsive cells, wherein said signal transduction is mediated by CD148 and CD148 immunoreactive proteins, classified in class 424, subclass 9.1.
- Group X Claims 155-160, drawn to a method of regulating signal transduction in uteroglobin-responsive cells wherein said signal transduction is mediated by PLA2 receptors and PLA2 immunoreactive proteins, classified in class 424, subclass 9.1.
- Group XI Claims 170-184, drawn to method of identifying proteins that interact with each other, classified in class 435, subclass 7.1.

It is respectfully requested that the restriction requirement be favorably reconsidered and withdrawn. Applicants maintain that a search of the prior art when examining claims 6-7, 13-14, 23-24, 31-32, 42-43, 51-52, 60-61, 69-70, 78-79, 89-90, 98-99, 107-108, 116-117, 123-124, 126-127, 129-130, 132-133, 135-136, and 138-139 should reveal any prior art for the remaining claims, i.e., 1-5, 8-12, 15-22, 25-30, 33-41, 44-50, 53-59, 62-69, 71-77, 80-88, 91-97, 100-106, 109-115, 118-122, 125, 128, 131, 134, 137, 140-154, 161-169 and 155-160.

Applicants note that MPEP § 803 states that if the search of an entire application can be made without serious burden, then the Examiner must examine it on the merits, even if it, as Examiner contends, includes claims to independent or distinct inventions.

Applicants submit that even if Groups I-XI represent distinct inventions, a search of the subject matter of each group would not be a serious burden on the Examiner. Applicants note that MPEP § 808.02 states that even if related inventions are shown to be distinct, the Examiner must also show serious burden "by appropriate explanation."

Applicants also respectfully note that Groups I, and III-X are all in the same class and subclass and thus searches within this subject matter would not impose an undue burden on the examiner.

Moreover, as a result of the GATT legislation limiting the term of a patent to twenty years from its effective filing date, the delay in the examination of the non-elected claims will likely result in the patent term for these claims being unnecessarily shortened.

Furthermore, it is likely that the same Examiner would be in charge of the divisional application; but since that divisional application will be examined at a much later date, the Examiner will have to conduct a duplicate, redundant search at the time he examines the divisional application. Alternatively, if a different Examiner is assigned to the divisional application, a significant loss of PTO efficiency would be incurred as a result of the examination of that divisional case.

In view of the foregoing, withdrawal of the requirement for restriction is respectfully requested.

If a telephone interview would be of assistance in the prosecution of this application, Applicants' undersigned attorney invites the Examiner to telephone him at her convenience at the number provided below.

No fee is believed to be necessary in connection with the filing of this Response. However, if any fee is required, the Commissioner is hereby authorized to charge such fee(s) to Deposit Account No. 50-0540.

Early and favorable examination on the merits is respectfully requested.

Respectfully submitted,

Dated: November 3, 2003

By: 

Robert E. Alderson, Jr.

Registration No. 44,500

Attorney for Applicants

KRAMER LEVIN NAFTALIS & FRANKEL LLP

919 Third Avenue

New York, New York 10022

(212) 715-7697